

Claims 44-72 are present in this application. Claims 1-43 have been canceled.

Claims 44-72 stand rejected under 35 USC 112, first paragraph. The examiner contends that the original disclosure lacks support for "(1) a single substrate body defined by an upper surface and formed with at least one cavity...and a primary optical path for accommodating the passage of a light beam aligned in a predetermined orientation with the upper cavity (claims 44, 56, 59, 63, 66, and 70, lines 2-5) and (2) a lower cavity formed on the lower surface of the substrate body (claim 56 line 6)."

II. THE REJECTION OF CLAIMS 44 AND 70

The foregoing rejection is respectfully traversed. The single substrate recited in claim 44 can be read on either the substrate 11 or the substrate 14 illustrated in, for example, Fig. 3. Assuming that the device illustrated in Fig. 3 is oriented such that the substrate 11 is the top and the element 16 is the bottom, the upper cavity can be considered either the cavity 29 in the substrate 11 or the cavity 21 in the substrate 14.

Claim 44 does not explicitly recite that the primary optical path 13 is in the single substrate. Accordingly, claim 44 reads on the device illustrated in Fig. 3 even though the primary optical path 13 is not in the substrate 11. However, if the single substrate is read as the substrate 14, the upper cavity 21 and the primary optical path 13 are both contained in the substrate 14. In fact, the substrate 14 includes a V-groove to receive the optical fiber or wave guide 13 as clearly shown in Figs. 1 and 2 of the present application. Moreover, the structure of the substrate 14 is nearly identical to the structure of the single substrate body 603 illustrated in Fig. 8 of the Maynard patent with respect to the shape of the upper cavity and the shape of the groove used to receive the optical fiber or wave guide. Accordingly, claim 44 is clearly supported by the original disclosure in the present application, and it is directed to the same invention claimed in the Maynard patent.

Claim 70 reads on the device illustrated in, for example, Fig. 3 for the reasons stated with respect to claim 44.

III. THE REJECTION OF CLAIMS 59, 65, AND 66

Claims 59, 63, and 66 have each been amended at the end of the last paragraph to delete "the upper" and insert --one--. Assuming that the top surface of the device is the substrate 11, the

mirror 18 illustrated in Fig. 3 directs the light beam toward the lower surface rather than the upper surface of the device. Thus, the original disclosure in the present application clearly supports the limitation at the end of claims 59, 63, and 66 of "so that the beam steering assembly may deflect a light beam in a direction toward one surface." The structure recited in claims 59, 63, and 66 questioned by the examiner is supported by the original disclosure for the reasons stated above with respect to claim 44.

Applicants submit that, whether these claims recite that the beam steering assembly may deflect the light beam in a direction toward "the upper", "the lower", or "one" surface is of no patentable significance. That is, it would have been obvious to one having ordinary skill in the art to arrange the mirror in the upper cavity so as to direct the light beam at either the upper surface or the lower surface, as desired. Thus, these claims are directed to the same patentable invention as the claims of the Maynard patent within the meaning of 37 CFR 1.601(n).

IV. THE REJECTION OF CLAIM 56

Claim 56 has been amended to recite a first substrate and a second substrate with the upper cavity formed in the first substrate and the lower cavity formed in the second substrate. The lower cavity is in the substrate 16. The second substrate 16 has a secondary optical element 19 disposed therein as recited in claims 57 and 58. The subject matter of claim 56 is clearly supported by the original disclosure of the present application. The first substrate recited in claim 56 corresponds to the single substrate recited in claim 44, and that recitation can be read on either the substrate 11 or the substrate 14 for the reasons pointed above with respect to claim 44.

Applicants submit that there is no patentable significance in forming the lower cavity in the same substrate as the upper cavity or in forming the lower cavity in a second substrate attached to the first substrate. That is, whether the cavities are formed in single substrate or in separate substrates would have been at most an obvious matter of choice on the part of one having ordinary skill in the art. Accordingly, claim 56 is directed to the same patentable invention as the claims in the Maynard patent within the meaning of 37 CFR 1.601(n).

V. CONCLUSION

For the reasons stated above, applicants respectfully request (1) that the rejection of claims 44-72 under 35 USC 112, first paragraph, be withdrawn and (2) that the present application be placed in an interference with the Maynard patent.

The Commissioner is hereby authorized to charge any fees which may be determined to be due in connection with this communication to our Deposit Account No. 06-1300 (Order No. A-62591-3/AJT). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,


Aldo J. Test, Reg. No. 18,048

FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
Suite 3400, Four Embarcadero Center
San Francisco, CA 94111-4187
(650) 494-8700